

REMARKS

Favorable reconsideration of this application in light of the following discussion is respectfully requested.

Claims 19-47 are presently active in this case. The present Amendment amends Claims 19-20 and adds new Claims 43-47 without introducing any new matter.

Claims 19-42 were rejected under 35 U.S.C. §103(a) as unpatentable over Goldberg (U.S. Patent No. 6,075,844) in view of Culbreth et al. (U.S. Patent No. 5,953,393, herein "Culbreth").

First, Applicant wishes to thank the Examiner Phan for the courtesy of an interview granted to Applicant's representative on August 31, 2005, at which time the outstanding issues in this case were discussed. Arguments similar to the ones developed hereinafter were presented and the Examiner indicated that he would reconsider the outstanding grounds for rejection upon formal submission of a response.

To clarify Applicant's invention, Claim 19 is amended to recite that the speech recognition module is "configured to edit the plurality of lists by means of spoken language." Independent Claims 28 and 36 are amended to recite a similar feature. These features find non-limiting support in the disclosure as originally filed, for example from page 6, line 21 to page 7, line 6. Further, Claims 19-20 are amended to correct minor formalities.

To vary the scope of protection recited in the claims, new Claims 43-44 are added. New Claim 43 depends upon Claim 36 and recites similar features to Claim 31. New Claim 44 depends upon Claim 19 and recites "the address module is further configured to be accessed via the internet to edit the plurality of lists."¹ New Claims 45-47 depend upon Claims 19, 28 and 36, respectively and recites features regarding a spoken guidance.² Since

¹ Finds non-limiting support in Applicants' Specification as originally filed, for example at page 7, lines 7-14.

² Idem at page 10, lines 3-17.

the new claims find non-limiting support in the original claims, they are not believed to raise a question of new matter.³

In response to the rejection of Claims 19-42 under 35 U.S.C. §103(a), Applicant respectfully requests reconsideration of this rejection and traverses the rejection, as discussed next.

Briefly recapitulating, Applicant's invention, as recited in Claim 19, relates to a message exchange connected to a public switched telephone network including a plurality of subscribers. The message exchange system includes: an address module configured to store a plurality of lists with subscriber identifications, each list being assigned to at least one of the subscribers; a receiving module configured to receive a spoken message from one of the subscribers in the telephone network via the telephone network, the one of the subscribers being a transmitting subscriber, and to store the spoken message with an identification of the transmitting subscriber; a speech recognition module configured to enable the transmitting subscriber to designate by means of spoken language at least one of the other subscribers as an addressee to whom the spoken message is addressed and configured to edit the plurality of lists by means of spoken language; a transmission module configured to transmit the stored message by means of an automatic call to the addressee, and configured to inquire if a reply is to be sent from the addressee to the transmitting subscriber; and a reply module configured to receive and to store the reply from the addressee. Independent Claims 28 and 36 recite similar features in the context of a method of handling spoken messages in a public switched telephone network (Claim 28) and in the context of a computer-readable data carrier (Claim 36).

As explained in Applicant's Specification at page 2 lines 9-12 with corresponding Figure 1, Applicant's invention improves upon background message exchange systems, since

³ See MPEP 2163.06 stating that "information contained in any one of the specification, claims or drawings of the application as filed may be added to any other part of the application without introducing new matter."

it proposes a new device and a new method for receiving, storing and transmitting spoken messages in telephone networks which in particular make it possible to receive a message from a plurality of subscribers of a public switched telephone network.

Turning now to the applied references, Goldberg discloses a message system with a remote messaging recording device, such as a portable analog tape recorder or a dictaphone, wherein the message is routed by PC, based on the spoken name of the recipient.⁴

However, Applicant respectfully submits that Goldberg does not teach a speech recognition module configured to edit the plurality of lists by means of spoken language. Goldberg's messaging system is able to send a message to a single or multiple recipients by accessing the corresponding codes from the database.⁵ Further, Goldberg appears to store only a single list of potential intended recipients and is assigned to only a single user, that is, the sending party associated with the PC 120.⁶ Therefore, a message sent to multiple recipients, as disclosed by Goldberg, is not a speech recognition module configured to edit the plurality of lists by means of spoken language, as claimed.

The applied reference Culbreth does not remedy the deficiencies of Goldberg. Even if we assume that the combination of these two references is proper, the combination fails to teach or suggest the above-noted features on a speech recognition module configured to edit the plurality of lists by means of spoken language. Culbreth discloses a personal telephone agent, wherein a person specifies a message and identifies a list of recipients to his personal messaging agent.⁷ Culbreth further teaches that the messaging agent delivers the message and collects a response from each messaging member. A person identifying a list of recipients to his personal messaging agent, as disclosed by Culbreth, *is not* a speech

⁴ See Goldberg in the Abstract and in column 3, lines 31-42.

⁵ See Goldberg at column 9, lines 5-12.

⁶ See Goldberg at column 4, lines 29-36.

⁷ See Culbreth in the Abstract and at column 3, lines 29-44.

recognition module configured to edit the plurality of lists by means of spoken language, as claimed.

Further, Applicant respectfully submits that both references, Goldberg and Culbreth, taken individually or in combination, fail to disclose all the features of Applicant's dependent claims.

First, Goldberg does not teach or suggest a speech recognition module is configured to enable the transmitting subscriber to create and administer at least one of the lists by means of spoken language, as claimed by Applicant's dependent Claims 20 and 35. The outstanding Office Action states that Goldberg teaches the message exchange, "wherein the speech recognition module is configured to enable the transmitting subscriber to create and administer the at least one of the lists by means of spoken language."⁸ Applicant respectfully disagrees. Goldberg's transmission system includes speech recognition software, which is merely interpreting the identification information for the intended recipient contained in the spoken header of the message.⁹ Accordingly, Goldberg *is silent* on the claimed speech recognition module configured to create and administer the plurality of lists. The applied reference Culbreth again does not remedy the deficiencies of Goldberg, since Culbreth expressively states that a person specifies a message and a list of recipients to his or her personal messaging agent¹⁰ and further teaches that the role of the telephone messaging agent described is simply to deliver messages and record responses, and may be able to interact with the recipients.¹¹

Accordingly, a personal messaging agent delivering responses to recipients, as taught by Culbreth, *is not* a speech recognition module configured to create and administer the plurality of lists, as would be required to meet Applicant's claimed feature. Therefore, even

⁸ See the outstanding Office Action at page 4, lines 3-6.

⁹ See Goldberg in the Abstract and at column 4, lines 22-25.

¹⁰ See Culbreth at column 3, lines 34-37.

¹¹ See Culbreth at column 5, lines 28-56.

if we assume that the combination of Goldberg and Culbreth is proper, the combination fails to teach every element of the claimed invention. Accordingly, Applicant respectfully traverses, and requests reconsideration of, this rejection based on these patents.¹²

Second, Goldberg and Culbreth do not teach or suggest the features of dependent Claims 25, 31 and 43, regarding the transmitting messages at times of low traffic load. The outstanding Office Action states that Goldberg discloses such a feature.¹³ Applicant respectfully disagrees. Goldberg merely teaches that depending how a message is transmitted to the intended recipient, a routing access code can include a variety of information, such as e-mail addresses, phone numbers or voice mail box number.¹⁴ Culbreth is also silent on such a feature. Therefore, the teachings of Goldberg and Culbreth, taken individually or in combination, do not teach or suggest a table with statistical information on the traffic load in the telephone network, wherein the transmission module refers to the table to transmit messages at times of low traffic load, as claimed in dependent Claim 25. Since dependent Claims 31 and 43 disclose similar features, Applicant respectfully traverses the rejection of dependent Claims 25, 31 and 43 and requests reconsideration of these rejections.

Consequently, in view of the present Amendment, no further issues are believed to be outstanding in the present application, and the present application is believed to be in condition for formal Allowance. A Notice of Allowance for Claims 19-47 is earnestly solicited.

¹² See MPEP 2142 stating, as one of the three "basic criteria [that] must be met" in order to establish a *prima facie* case of obviousness, that "the prior art reference (or references when combined) must teach or suggest all the claim limitations," (emphasis added). See also MPEP 2143.03: "All words in a claim must be considered in judging the patentability of that claim against the prior art."

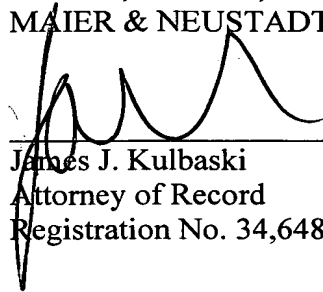
¹³ See the outstanding Office Action from page 4, line 20 to page 5, line 2.

¹⁴ See Goldberg at column 4, lines 34-40.

Should the Examiner deem that any further action is necessary to place this application in even better form for allowance, the Examiner is encouraged to contact Applicant's undersigned representative at the below listed telephone number.

Respectfully submitted,

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